

Hearing:
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Paper No. 13
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Onyx Acceptance Corporation

Serial No. 75/207,208

Jill M. Pietrini and Michael B. Adlin of Manatt, Phelps &
Phillips for applicant.

Laurie S. Mintzer, Trademark Examining Attorney, Law Office
101 (Jerry Price, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Onyx Acceptance Corporation has filed a trademark
application to register the mark AUTOMOTIVE BANKING NETWORK
for "loan financing services."¹

The Trademark Examining Attorney has finally refused
registration, under Section 2(e)(1) of the Trademark Act,

¹ Serial No. 75/207,208, in International Class 36, filed December 3,
1996, based on an allegation of a bona fide intention to use the mark
in commerce.

15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register.

The Examining Attorney contends that "the average consumer will understand that the terms 'AUTOMOTIVE,' 'BANKING' and 'NETWORK,' taken as a whole, describe a banking network for automobiles or automobiles"; that applicant's broad identification of services encompasses loan financing services for automobiles; and that, therefore, the mark is merely descriptive of applicant's services. The Examining Attorney submitted dictionary excerpts defining "automotive" as "of, relating to, or concerned with self-propelled vehicles or machines," defining "banking" as "the business of a bank or a banker,"² and defining "network" as "telecommunications, computers, a system containing any combination of computers, computer terminals, printers, audio visual display devices, or telephones interconnected by telecommunications equipment or cables used to transmit or receive information" and "an association of individuals having a common interest, formed

² *Merriam Webster's Collegiate Dictionary*, 10th ed., 1996.

to provide mutual assistance, helpful information, or the like."³ Additionally, in support of her position, the Examining Attorney submitted copies of 11 third-party registrations wherein the term NETWORK is disclaimed in marks registered for loan and/or banking services; a copy of a third-party registration of the mark PERFORMANCE AUTOMOTIVE NETWORK and design for automobile dealership services, including a disclaimer of AUTOMOTIVE NETWORK; and a copy of a third-party registration of the mark LEASENET AUTOMOTIVE LEASING NETWORK and design for automotive vehicle leasing and renting services, including a disclaimer of AUTOMOTIVE LEASING NETWORK.

Applicant contends, on the other hand, that AUTOMOTIVE is not descriptive of applicant's services because, as identified, its services do not refer specifically to automotive loan financing; and that AUTOMOTIVE does not describe anything about loan financing services. Applicant argues, further, that, because of the several meanings of the words BANKING and NETWORK, it is not immediately clear from the mark AUTOMOTIVE BANKING NETWORK what services are offered; and that consumers may believe that the mark identifies "a facility which stores a large number of cars

³ *Random House Unabridged Dictionary*, 2nd ed., 1993. We take judicial notice of this excerpt, as it was submitted with the Examining Attorney's brief.

for automobile dealers," or "a bank for individuals or companies in the automobile industry," or "a television network or an affiliation of banks." Applicant adds that the phrase AUTOMOTIVE BANKING is an incongruous combination of these two words. Applicant lists three third-party registrations in support of its position, alleging that these registrations are not registered under Section 2(f) of the Trademark Act. While applicant did not make these registrations properly of record by submitting copies of these registrations from the records of the Patent and Trademark Office (PTO), the Examining Attorney did properly submit copies of these registrations and pointed out that each of these three registrations contains disclaimers of AUTOMOTIVE and NETWORK or of BANKING NETWORK.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality,

feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the Examining Attorney that the identification of services, "loan financing services," is very broad and encompasses automotive financing; and that, considering the mark in connection with the identified services, and based on the dictionary definitions of the individual words comprising the mark, AUTOMOTIVE BANKING NETWORK merely describes a banking network for financing automotive vehicles. We find applicant's arguments to the contrary to be unavailing.

In the present case, it is our view that, when applied to applicant's services, the term AUTOMOTIVE BANKING NETWORK immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, as indicated herein. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for

purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term AUTOMOTIVE BANKING NETWORK as it pertains to loan financing services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

R. L. Simms

T. J. Quinn

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board